

REMARKS

This paper is filed responsive to the Final Office Action mailed November 24, 2009. Claims 1-15 are pending in the application. Claims 1-4, 6 and 7 are amended. No new matter is added.

Informalities

The Examiner objected to the abstract, several informalities and has renewed the objections from the Office Action of May 12, 2009 due to the lack of headings within the Specification as the amendments made in the most recent amendment were made with respect to the U.S. Application Publication No. 2007/0276400, rather than the specification as filed. Applicants have supplied a new Abstract, have amended the specification with respect to the application as filed to, among other things, correct the spelling of “finalized”, errors in the reference numbers, and to add appropriate headings. As a result, Applicants request withdrawal of the objections.

Claim Objections

Claim 4 stands objected to because of the informality in line 2, the phrase “between first” should read “between the first clamping.” Applicant has amended claim 4, line 2 to read “between the first clamping”, as suggested by the Examiner, and requests that the objection be withdrawn.

Claim Rejections

Claims 1-4 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Examiner states that the claims contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the terms upper clamping surface and lower clamping surface are stated to be unclear. In the original claim set, two pairs of clamping surfaces were claimed as elements of the independent claim—“a lower pair of clamping surfaces provided by the drill

guide bulb and the internal wall of the recess respectively, and an upper pair of clamping surfaces on the drill guide and the housing respectively”.

To clarify the claimed invention, Applicants have amended the claims to replace “an upper clamping surface” with “a first clamping surface” and “a lower clamping surface” with “a second clamping surface”. Applicants submit that the specification supports such an amendment. An example of the claimed first clamping surface is shown in Figure 4 as washer 34, and an example of the claimed second clamping surface is shown in Figure 4 as clamping surface 28. With that clarification, Applicants submit that the remainder of the 112 objections on this point are mooted, as the second clamping surface can be provided on the collar (as per claim 2), the second clamping surface can be convex (as per claim 3), and, the o-ring can be disposed between the first and second clamping surfaces (as per amended claim 4). Applicants request that the rejection be withdrawn.

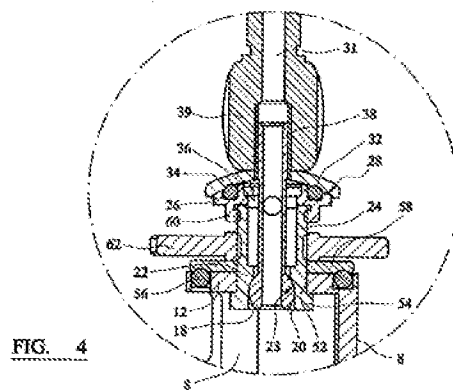
Claims 6 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the limitation “the actuator” in line 2, lacks sufficient antecedent basis. Applicants have amended claim 6 to have it depend from claim 5, to provide proper antecedent basis, and seek withdrawal of the rejection.

Claims 1-3 and 7-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,595,999 (“Marchione”) in view of US Application Publication No. 2006/0271058 (“Ashton”). Applicants traverse the rejection.

Claim 1 claims a drill guide assembly that comprises a drill guide that includes a sleeve and a bulb at one end of the sleeve; a frame fastenable to the bone comprising a housing having an internal surface that defines a recess, the recess being configured to receive the bulb such that the sleeve extends out of the recess, the drill guide and housing being movable relative to one another from a first position, where the angular orientation of the drill guide sleeve relative to the housing can be adjusted by movement of the bulb within

the recess, to a second position, where the bulb of the drill guide contacts the internal surface of the housing; a first clamping surface carried on the drill guide; and a second clamping surface carried on the housing, the first clamping surface and second clamping surface configured to contact one another when the drill guide and the housing are moved from the first position to the second position, the first clamping surface being spaced apart from the bulb along the drill guide sleeve.

One embodiment of the claimed invention is depicted in detail in Figure 4 of the current application:



Paragraphs 41-44 of the current application, describes the embodiment depicted in Figure 4 as having, among other elements, a sleeve 14; a bulb 18; a housing 22 having a recess 20; a collar 26 having a clamping surface 28. “The drill guide sleeve 14 has a washer 34 positioned on it which provides a clamping surface 36 facing towards the clamping surface 28 on the collar 26.” Paragraph 0044 of the current application. As is shown in Figure 4, clamping surface 28 is spaced apart from bulb 18.

Turning to the prior art, Marchione is relied on as the primary reference. Marchione fails, however to disclose each element of claim 1. Marchione does not describe at least the limitations of “a first clamping surface carried on the drill guide” and “a second clamping surface carried on the housing”, where “the first clamping surface and second clamping surface [are] configured to contact one another when the drill guide and the housing are moved from the first position to

the second position, the first clamping surface being spaced apart from the bulb along the drill guide sleeve.”

Marchione provides a drill guide that permits angular adjustment of the drill axis. As is described in the background of the current application at paragraph [0004], Marchione

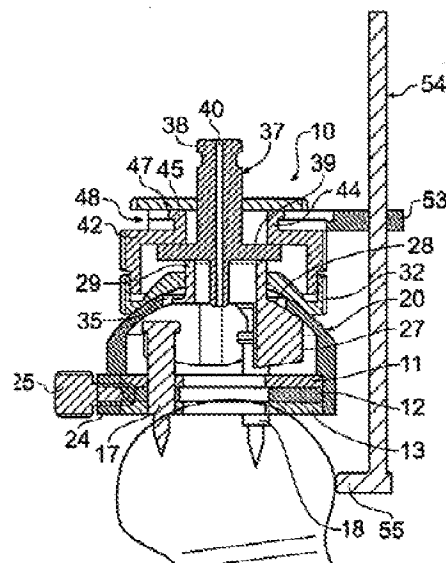
“discloses a drilling jig which includes a drill guide tube with a rounded head which is supported in a housing. The head is able to pivot within the housing so that the axial orientation of the drill guide tube relative to the housing can be adjusted. The tube can be clamped against adjustment. The clamp comprises upper and lower housing parts which can be drawn together so as to grip the rounded head of the clamp on opposite sides thereof (see FIGS. 6 and 10). A transverse arm can be used to obtain high clamping forces.

The clamping mechanism of Marchione, however, may not provide for sufficient force to clamp the head 7 “to prevent movement of the drill guide when the jig is in use”. Marchione relies on the force generated between head 7 and clamping elements 5 only to fix the orientation of guide tube 6. There is no additional clamping surface that is spaced apart along the drill guide sleeve from the head 7 and clamping elements 5.

Thus, Marchione lacks at least the last two claimed of claim 1—the upper clamping surface carried on the drill guide and the lower clamping surface carried on the housing, where the upper clamping surface and lower clamping surface are configured to contact one another when the drill guide and the housing are moved from the first position to the second position, and where the upper clamping surface is spaced apart from the bulb along the drill guide sleeve.

The Examiner relies on Ashton to provide the elements that are not described in Marchione. Applicants submit, however, that Ashton also fails to describe the elements that are not described in Marchione. As a result, Applicants submit that the combination of Marchione and Ashton cannot render the claimed invention obvious.

Ashton describes a guide wire location means 10 that includes a base part, consisting of three plates 11, 12, 13 that have studs that extend from the plates into the bone. The base part is disposed within enclosure 20. See Ashton, paragraph 12 and 13. Within enclosure 20 is received an adjustment member 26 that has a boss 29 (or threaded sleeve, as the Examiner characterizes the element) that projects through the opening 23 of enclosure 20. Adjustment member 26 can be adjusted relative to the enclosure 20. See Ashton paragraph 22. The boss 29, however, is not part of the drill guide of Ashton. The drill guide of Ashton is shown as element 37, referred to in Ashton as cannula guide 37. See Figure 1 of Ashton, reproduced below.



The cannula guide 37 of Ashton does not have a bulb formed on one end as is claimed. As a result, cannula guide does not describe an upper clamping surface carried on the drill guide that is spaced apart from the bulb along the drill guide sleeve. On the other hand, the element that the Examiner states as satisfying the bulb element, i.e., adjustment member 26, does not serve as a drill guide. Inherent in the claimed “drill guide” element is that the element must serve to guide a drill. Adjustment member 26 does not serve to guide a drill. Cannula guide 37 serves that function in Ashton.

The Examiner states that it would have been obvious to one of ordinary skill in the art at the time of the invention “to construct the invention of Marchione ... wherein the upper

clamping surface is spaced apart from a bulb-like member along a threaded sleeve of the drill guide ... in view of Ashton et al. in order to provide structure for accurately securing a drill guide to the femoral head to improve the accuracy of installation of a prosthetic hip resurfacing device.” November 24, 2009, Office Action, page 6. Simply stating that it would be obvious to combine the two references does not make it so. The Examiner has failed to supply any reason why one would combine Marchione with Ashton.

Ashton does not describe the elements that Marchione fails to describe. As a result, Applicants submit that the combination cannot render the invention of claim 1 obvious and request withdrawal of the rejection. With respect to the claims that depend from claim 1, Applicants submit that they too are patentable over the proposed combination, at least because they depend from claim 1, and seek withdrawal of the rejection with respect to those claims as well.

Claims 4 and 6 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Marchione in view of Ashton and in further view of U.S. Patent No. 3,627,334 (“Reddy”). Applicants traverse the rejection. Applicants submit that claims 4-6 are also patentable over this proposed combination, at least because they depend from claim 1, and seek withdrawal of the rejection with respect to those claims as well.

Please charge any fee associated with the prosecution of this application to Deposit Account No. 10-0750.

Respectfully submitted,

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